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Attorney Docket No.: 01.39

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19/Reply
Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: WOLF, Shane D.

Serial No.: 09/923,113

Group Art Unit: 3732

Filed: August 6, 2001

Examiner: MANAHAN, T.

For: Stress Relieving Gel Handle Tools For Salon And Spa

REPLY BRIEF UNDER 37 CFR 1.193(b)(1)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following constitutes Applicant's reply to the Examiner's Answer, mailed December 2, 2003. Applicant acknowledges the correction made by the Examiner in section (4), "Status of Amendments After Final." The Examiner has correctly described the situation.

In section (10) "Grounds of Rejection" the Examiner wrote, "Tindall discloses the invention essentially as claimed except for the viscous material."

This characterization of Tindall is misleading. It's not only that Tindall does not disclose a viscous material, it's that Tindall specifically does disclose a non-viscous material. It's one thing to say that Tindall does not disclose an element and McCall does disclose the element, let's see if they should be combined. It's a much different thing to say let's replace a critical element of Tindall with a substantively different element borrowed from McCall. In this case, the elements in question exclude one another. Tindall teaches using a non-viscous medium to obtain scissors grips having certain characteristics. In contrast McCall teaches using a viscous medium to obtain writing implement grips having different characteristics. The desired characteristics are themselves exclusive of one another. Tindall describes grips that immediately return to their original shape when pressure is abated. McCall describes grips that retain shape for a substantial

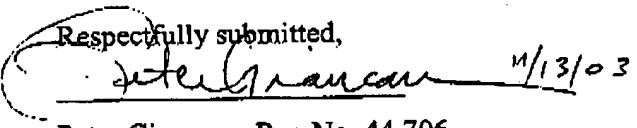
period after pressure is abated. Therefore, making the substitution of a viscous medium for a non-viscous medium, as suggested by the Examiner, renders the Tindall grips inoperative for their intended purpose. This alone defeats prima facie obviousness.

Once again, in the Examiner's Answer, the Examiner has stated that McCall describes "problems with such air filled grips". The Examiner has appealed to column 1, lines 55-65 of McCall. But even a casual reading of that whole paragraph clearly shows that McCall is only describing the problems of air filled grips as it relates to writing implements. What makes the Examiner think that any other handheld implements (i.e. shears) with air-filled grips would suffer from the same problems? There is no suggestion in McCall or Tindall that this is the case. At column 4, lines 10-12 McCall does state that his grip can be applied to "other manual implements with working tips, for example, paint brushes, jeweler's tools and other devices". But McCall does not say why you may want to do that. And even if he did, it still doesn't teach or suggest anything about the situation of scissors grips. Scissors are not the same as writing implements. They are handled and used differently and for the most part, the tip of the scissors is not used. There is simply no suggestion in McCall or any of the cited references that air-filled grips on scissors are a problem. With that in mind, we turn to the Tindall reference which specifically teaches that air-filled scissors grips are the way to go and does not teach the use of a viscous medium. Examining the whole of these two references for all they fairly disclose, applicant fails to see why a person of skill in art would be motivated to apply the "solution" of McCall to the scissors of Tindall. This alone defeats prima facie obviousness.

CONCLUSION

Applicants have shown, by the foregoing arguments, that the PTO has not borne its burden of establishing obviousness of claims 14, 17-24 of the present application. Applicants therefore respectfully request that the Board reverse the holding of obviousness under 35 USC §103(a), and pass the present claims to issue.

Respectfully submitted,

 11/13/03
Peter Giancana, Reg.No. 44,706
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Fax Cover Sheet

11/13/03

4:10 PM

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FROM: Peter Giancana
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RE: 09/923,113**CC:**Number of pages including cover sheet: **5**

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REPLY Brief (2)
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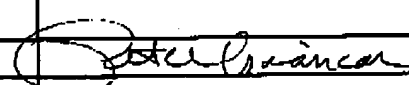
PTO/SB/21 (03-03)

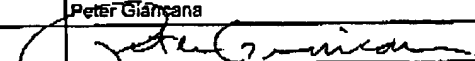
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/923113	
	Filing Date	August 6, 2001	
	First Named Inventor	WOLF, S.	
	Art Unit	3732	
	Examiner Name	MANAHAN, T.	
Total Number of Pages In This Submission	5	Attorney Docket Number	01.39

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax Cover Sheet
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Signature		
Date	November 13, 2003	

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FEE TRANSMITTAL
for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 320**Complete If Known**

Application Number	09/923113
Filing Date	Aug 6, 2001
First Named Inventor	WOLF
Examiner Name	Manahan
Art Unit	3732
Attorney Docket No.	01.39

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:

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FEE CALCULATION**1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 750	2001 375	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$) **2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 410	2252 205	Extension for reply within second month	
1253 930	2253 465	Extension for reply within third month	
1254 1,450	2254 725	Extension for reply within fourth month	
1255 1,970	2255 985	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	330
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,300	2453 650	Petition to revive - unintentional	
1501 1,300	2501 650	Utility issue fee (or reissue)	
1502 470	2502 235	Design issue fee	
1503 630	2503 315	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.129(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 330**SUBMITTED BY**

Name (Print/Type) Peter Giancana

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(Attorney/Agent)

Telephone 631-531-1193

Signature

Date November 13, 2003

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